



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,678	03/03/2004	Matthew Rubin Lerner	003797.00912	2303

28319 7590 10/31/2006

BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,678

Applicant(s)

LERNER ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/06 (2pgs)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the applicant's amendment, filed on 8/18/2006.
2. Applicant has amended claim 1, and added new claims 5-12.
3. Claims 1-12 are pending in the case, claims 1 and 7 are independent claims.
4. Acknowledgement is made to the applicant's submission of an Information Disclosure Statement, filed 8/10/2006.
5. Applicant has amended the specification in response to the objections cited by the examiner in the *Specification* section of the previous office action (dated 6/16/2006). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the specification are withdrawn.
6. Examiner's rejection of claim 1-4, made under 35 USC 101 in the *Claim Rejections – 35 USC 101* section of the previous office action (dated 6/16/2006) is withdrawn in view of the amended claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

8. Claims 1, 5-7, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

9. **Regarding claims 1, 6, 7 and 12**, the amendment filed 8/18/2006 adds the following limitation: *"indicia of attributes"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

10. **Regarding claims 5 and 11**, the amendment filed 8/18/2006 adds the following limitation: *"the obtained set of annotated documents includes at least two documents"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

12. Claims 1-4 remain rejected and claims 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Golovchinsky et al. US Patent 6,389,435, filed 2/5/1999, patented 5/14/2002 (hereinafter Golovchinsky).

13. **Regarding independent claim 1**, Golovchinsky discloses a plurality of annotated documents, where the annotated documents are web-based documents with annotation data. Golovchinsky discloses web-based documents as hypertext documents (see column 1, lines 15-40) used on the Internet (column 3, lines 31-39). Golovchinsky discloses annotation data as digital ink in Figures 2 and 3 (shown at reference signs 42, 44 and 46).

Golovchinsky discloses a searching an index of annotation data attributes to obtain a set of documents that is a subset of the plurality of annotated documents. Golovchinsky recites: *"this invention is directed to an electronic system that facilitates navigation from an index to portions of a document or documents that are of interest to the user"* (column 1, lines 7-11) and *"by making a variety of different types and styles of freeform digital ink marks in*

the index, the relationships between terms in a document can be more quickly comprehended by a user” (column 2, lines 16-19).

Golovchinsky discloses generating a thumbnail of the annotated document in figure 4. Golovchinsky discloses associating searchable attributes to the annotation data with a searchable index. Golovchinsky recites: *“this invention facilitates navigation from an index to portions of a document that are of interest to a user using freeform digital ink. A user can mark terms in an index page using freeform digital ink and the freeform digital ink mark is copied to instances of the annotated terms that occur in the document”* (column 1, line 67 to column 2, line 5). Golovchinsky discloses searching the plurality of annotated documents for a subset of the annotated documents. Golovchinsky recites: *“An embodiment of the system and method of this invention treats the selection of multiple original freeform digital ink marks as a query that causes the system to display a ranked list of search results”* (column 4, lines 27-31).

14. **Regarding dependent claim 2**, Golovchinsky discloses an annotation element in Figures 2 and 3 at reference signs 42, 44 and 46.
15. **Regarding dependent claim 3**, Golovchinsky discloses an annotation element in the form of ink marks in Figures 2 and 3 at reference signs 42, 44 and 46.
16. **Regarding dependent claim 4**, Golovchinsky discloses ink mark shapes in Figures 2 and 3 at reference signs 42, 44 and 46.

Art Unit: 2178

17. **Regarding dependent claim 5**, Golovchinsky discloses set of annotated documents includes at least two documents. Golovchinsky recites: *"this invention is directed to an electronic system that facilitates navigation from an index to portions of a document or documents"* (column 1, lines 7-11).
18. **Regarding dependent claim 6**, Golovchinsky discloses the indicator of the attributes of the annotation data is a pointer in Figures 2 and 3. In Figure 2, at reference signs 42, 44 and 46, the search attributes are indicated by the digital ink marks shown, wherein each digital ink mark indicator has a distinct shape. In figure 3, the digital ink mark pointers are shown at each occurrence of the attributes indicated in Figure 2.
19. **Regarding claims 7-12**, the claims are directed toward a computer readable media for the method of claims 1-6, and are rejected using the same rationale.

Response to Arguments

20. Applicant's arguments filed 8/18/2006 have been fully considered but they are not persuasive.
21. Regarding independent claim 1, applicant states: "Golovchinsky's discussion of a list of passages fails to teach or suggest obtaining a set of annotated documents. Also, the query in Golovchinsky appears to search the text of the original document. There is no mention of searching for at least

Art Unit: 2178

one of the attributes of annotation data" (page 8, last paragraph, of the reply filed 8/18/2006). Applicant is directed to the rejection of claim 1, as recited above. Golovchinsky discloses a searching an index of annotation data attributes to obtain a set of documents that is a subset of the plurality of annotated documents. Golovchinsky recites: *"this invention is directed to an electronic system that facilitates navigation from an index to portions of a document or documents that are of interest to the user"* (column 1, lines 7-11) and *"by making a variety of different types and styles of freeform digital ink marks in the index, the relationships between terms in a document can be more quickly comprehended by a user"* (column 2, lines 16-19).

Applicant further states: *"Golovchinsky fails to teach or suggest receiving a plurality of annotated documents"* (page 9, first paragraph, of the response filed 8/18/2006). Applicant is directed to the rejection of claim 1 as recited above. Golovchinsky discloses a plurality of annotated documents as described above.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

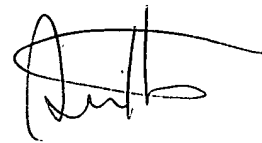
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
Patent Examiner
October 27, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER